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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Paul C. Kocher et al.

Application No.: 10/695,256

Filed: 10/27/2003

For: USING SMARTCARDS OR OTHER
CRYPTOGRAPHIC MODULES FOR
ENABLING CONNECTED DEVICES
TO ACCESS ENCRYPTED AUDIO
AND VISUAL CONTENT

Confirmation No.: 4709

Group Art Unit: 2132

Examiner: not yet known

Attorney Docket No: 44424162-8746

**INFORMATION DISCLOSURE
STATEMENT**

SONNENSCHN NATH & ROSENTHAL LLP
Customer No. 26263

M/S AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited
with the United States Postal Service as First Class Mail in an
envelope, addressed to: M/S Amendment, Commissioner for
Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on
September 23, 2004.

SONNENSCHN NATH & ROSENTHAL LLP

Dated: 23 Sept 04 By: [Signature]

Michael C. Martensen

Sir:

Applicants submit herewith patents, publications or other information [attached hereto
and listed on the attached Form PTO-1449 (modified)] of which they are aware, which they
believe may be material to the examination of this application and in respect of which there may
be a duty to disclose in accordance with 37 CFR § 1.56.

This Information Disclosure Statement:

- (a) ☐ accompanies the new patent application submitted herewith. 37 CFR § 1.97(a).
- (b) ☐ is filed within three months after the filing date of the application or within three
months after the date of entry of the national stage of a PCT application as set
forth in 37 CFR § 1.491.
- (c) ☒ as far as is known to the undersigned, is filed before the mailing date of a first
Office Action on the merits, or before a first office action after filing a Request
for Continued Examination under §1.114.

- (d) ☐ is filed after the first office action and more than three months after the application's filing date or PCT national stage date of entry filing but, as far as is known to the undersigned, prior to the mailing date of either a final rejection or a notice of allowance, whichever occurs first, and is accompanied by either the fee (\$180) set forth in 37 CFR § 1.17(p) or a certification as specified in 37 CFR § 1.97(e), as checked below.
- (e) ☐ is filed after the mailing date of either a final rejection or a notice of allowance, whichever occurred first, and the Issue Fee has not been paid, and is accompanied by the fee (\$130) set forth in 37 CFR § 1.17(i)(1) and a certification as specified in 37 CFR § 1.97(e), as checked below. This document is to be considered as a petition requesting consideration of the information disclosure statement.

A list of the patent(s) or publication(s) is set forth on the attached Form PTO-1449 (Modified). A copy of the items on PTO-1449 (Modified) is supplied herewith, except as noted below.

Those patent(s) or publication(s) which are marked with an asterisk (*) in the attached form PTO-1449 (Modified) are not supplied because they are (a) either U.S. Patents and this an application filed after June 30, 2003, or (b) were previously cited by or submitted to the Office in prior U. S. Patent Application No. 09/948,473, filed 09/06/2001, now U.S. Patent No. 6,640,305 which is a continuation of U.S. Patent Application No. 09/389,268, filed 09/02/1999, now U.S. Patent No. 6,289,455, and relied upon in this application for an earlier filing date under 35 U.S.C. § 120.

A concise explanation of relevance of the items listed on form PTO-1449 (Modified) is:

- (h) ☒ not given
- (i) ☐ given for each listed item
- (j) ☐ given for only non-English language listed item(s) [Required]
- (k) ☐ is in the form of an English language copy of a Search Report from a foreign patent office, issued in a counterpart application, which refers to the relevant portions of the references [copy attached].

The Examiner is reminded that a "concise explanation of the relevance" of the submitted items "may be nothing more than identification of the particular figure or paragraph of the patent or publication which has some relation to the claimed invention," MPEP § 609.

While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR § 1.56, it is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR § 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR § 1.56(a) exists. It is submitted that the Information Disclosure Statement complies with 37 CFR § 1.98 and MPEP § 609 and the Examiner is respectfully requested to consider the listed references.


The Commissioner is hereby authorized to charge our Deposit Account No. 19-3140, for any fees required in connection with the filing of this Information Disclosure Statement. **A duplicate copy of this Notice is enclosed for this purpose.** In particular, in the event that an Office Action has crossed in the mail with this Information Disclosure Statement, the Commissioner is authorized to charge the above-named deposit account for any fees required pursuant to CFR §§ 1.17(p) or 1.17(i)(1).

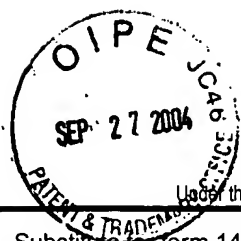
This request is made on behalf of the applicants and their assignee under 37 CFR 1.34(a). The Commissioner is hereby authorized to credit overpayments or to charge any deficiency in connection with this filing to Deposit Account No. 19-3140. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

SONNENSCHN NATH & ROSENTHAL LLP

Dated: 23 September 2004

By: 
Michael C. Martensen, Reg. No. 46,901
Attorney under Rule 34(a)



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|---|---|--------------------------|------------------|------------------------|---------------|
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) | | Complete if Known | | | |
| | | Application Number | 10/695,256 | | |
| | | Filing Date | October 27, 2003 | | |
| | | First Named Inventor | Paul C. Kocher | | |
| | | Group Art Unit | 2132 | | |
| | | Examiner Name | not yet known | | |
| Sheet | 1 | of | 3 | Attorney Docket Number | 44424162-8746 |

| U.S. PATENT DOCUMENTS | | | | | |
|-----------------------|--------------------------|--|--------------------------------|--|---|
| Examiner Initials* | Cite No. ¹ | Document Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
| | | Number-Kind Code ² (if known) | | | |
| | AA | *4,222,068 | 09/09/1980 | Thompson | |
| | AB | *4,521,852 | 06/04/1985 | Gutttag | |
| | AC | *4,521,853 | 06/04/1985 | Gutttag | |
| | AD | *4,613,901 | 09/23/1986 | Gilhousen et al. | |
| | AE | *4,634,808 | 01/06/1987 | Moerder | |
| | AF | *4,696,034 | 09/22/1987 | Wiedemer | |
| | AG | *4,887,296 | 12/12/1989 | Horne | |
| | AH | *5,029,207 | 07/02/1991 | Gammie | |
| | AI | *5,237,610 | 08/17/1993 | Gammie et al. | |
| | AJ | *5,293,424 | 03/08/1994 | Holtey et al. | |
| | AK | *5,436,621 | 07/25/1995 | Macko et al. | |
| | AL | *5,442,704 | 08/15/1995 | Holtey | |
| | AM | *5,592,552 | 01/07/1997 | Fiat | |
| | AN | *5,619,247 | 04/08/1997 | Russo | |
| | AO | *5,754,647 | 05/19/1998 | Hsu | |
| | AP | *5,757,919 | 05/26/1998 | Herbert et al. | |
| | AQ | *5,764,762 | 06/09/1998 | Kazmierczak et al. | |
| | AR | *5,774,546 | 06/30/1998 | Handelman et al. | |

| FOREIGN PATENT DOCUMENTS | | | | | | |
|--------------------------|-----------------------|---|--------------------------------|--|---|--------------------------|
| Examiner Initials* | Cite No. ¹ | Foreign Patent Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ⁶ |
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| Examiner Signature | Date Considered |
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This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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| Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(use as many sheets as necessary)</i> | | | | Complete if Known | |
| | | | | Application Number | 10/695,256 |
| | | | | Filing Date | October 27, 2003 |
| | | | | First Named Inventor | Paul C. Kocher |
| | | | | Group Art Unit | 2132 |
| Examiner Name | not yet known | | | | |
| Sheet | 2 | of | 3 | Attorney Docket Number | 44424162-8746 |

| U.S. PATENT DOCUMENTS | | | | | |
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| | | Number-Kind Code ² (if known) | | | |
| | AS | *5,799,080 | 08/25/1998 | Padmanabhan et al. | |
| | AT | *5,802,274 | 09/01/1998 | Dorak et al. | |
| | AU | *5,809,140 | 09/14/1998 | Rubin et al. | |
| | AV | *5,825,878 | 10/20/1998 | Takahashi et al. | |
| | AW | *5,852,290 | 12/22/1998 | Chaney | |
| | AX | *5,892,899 | 04/05/1999 | Auicsmith et al. | |
| | AY | *5,892,900 | 04/06/1999 | Ginter et al. | |
| | AZ | *5,923,759 | 07/13/1999 | Lee | |
| | BA | *5,982,899 | 11/09/1999 | Probst | |
| | BB | *5,999,623 | 12/07/1999 | Bowman et al. | |
| | BC | *6,009,177 | 12/28/1999 | Sudia | |
| | BD | *6,041,412 | 03/21/2000 | Timson et al. | |
| | BE | *6,044,155 | 03/28/2000 | Thomlinson et al. | |
| | BF | *6,049,608 | 04/11/2000 | Ablowitz et al. | |
| | BG | *6,069,957 | 05/30/2000 | Richards | |

| FOREIGN PATENT DOCUMENTS | | | | | | |
|--------------------------|-----------------------|---|--------------------------------|--|---|--------------------------|
| Examiner Initials* | Cite No. ¹ | Foreign Patent Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ⁶ |
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Approved for use through 10/31/2002. OMB 0651-0031

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| Examiner Name | not yet known | | | | |
| Attorney Docket Number | 44424162-8746 | | | | |
| Sheet | 3 | of | 3 | | |

| OTHER ITEMS – NON PATENT LITERATURE DOCUMENTS | | | |
|---|----------------------|---|----------------|
| Examiner Initials* | CiteNo. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
| | BH | *CHOR, B., et al. "Tracing Traitors", Advances in Cryptology-CRYPTO '94 (Springer-Verag, 1994), pp. 256-270 (Cambridge, United Kingdom). | |
| | BI | *"H' Cards and You: The 'H' Card Hacking FAQ", By an Anonymous Member of TCUP, revision date August 10, 1998, world wide web at Http://www.dr7.com/faqs/dsstechfaq.html . | |
| | BJ | *KOMMERLING, O. and Kuhn, M., "Design Principles for Tamper-Resistant Smartcard Processors," USENIX Workshop on Smartcard Technology, May 10-11, 1999, USENIX Association, pp. 1-12, 9-20, ISBN 1-1880446-34-0 (Cambridge, United Kingdom). | |
| | BK | *McCORMAC, J., "European Scrambling Systems," (Circuits, Tactics and Techniques. 5) Waterford University Press 1996 (Waterford, Ireland). | |
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| Examiner Signature | | Date Considered | |
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